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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/552,073	04/19/2000	Adam Coyle	06042-0145	3055

24728 7590 11/03/2004

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EXAMINER

COLBERT, ELLA

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/552,073	Applicant(s) COYLE ET AL.	
	Examiner Ella Colbert	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-157 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 26-157 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 26-157 are pending in this communication filed 08/12/04 entered as Response To Office Action/Restriction Requirement. Claims 1-25 have been previously canceled and claims 26-157 have been previously added. Applicant's election with traverse of Group II, claims 48-57 and 85-129 in the reply of 08/12/04 is acknowledged.

Arguments With Traverse

2. The traversal is on the ground(s) that claim 26 is directed, among other things, to aspects of an improvement to a licensed money transmitter payment system for issuing a negotiable instrument in response to a direct deposit of funds at an affiliated regulated financial institution, claim 48 is directed to aspects of a method for a licensed money transmitter to issue a prepaid negotiable instrument based on direct deposit of funds at a regular financial institution, claim 58 is directed to aspects of a computer-controlled negotiable instrument payment system based on direct deposit of funds at a regulated financial institution, utilizing a licensed money transmitter's computer system, claim 85 is directed to aspects of a method for a licensed money transmitter to provide direct deposit capability to individuals not having a pre-established relationship with a regulated financial institution and to conduct financial transactions with a cash card for accessing funds corresponding to the direct deposit, claim 118 is directed to aspects of a method for a licensed money transmitter to issue a prepaid negotiable instrument to an individual based on the direct deposit of funds at a regulated financial institution based on use of an account number and a pin, and claim 122 is directed to a computer-

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controlled negotiable instrument payment system for use by a licensed money transmitter, for conducting negotiable instrument transactions conducted by an individual based on the direct deposit of funds at a regulated institution and all of the claims in either of Groups I and II involve direct deposit of funds and prepaid negotiable instruments. The claims of Groups I and II should remain together in the same application and patent.

Response to Arguments With Traverse

3. Applicant's arguments have been considered and the prior restriction is hereby withdrawn in view of a new Election/Restriction Requirement as set forth here below.

Election/Restrictions

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 26-84, and 118-129, drawn to maintaining an account at a financial institution and sweeping the funds and an account sweep control module classified in class 705, subclass 39.
- II. Claims 85-117, drawn to conducting financial transactions with a cash card, classified in class 705, subclass 40.
- III. Claims 130-157, drawn to providing an anonymous transaction, classified in class 705, subclass 42.

4. Inventions Group I, Group III are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other

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combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Group I has separate utility such as maintaining an account at a financial institution and sweeping the funds and an account sweep control module. The subcombination group II has separate utility such as providing an anonymous transaction.

Inventions Group I and Group II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group I has separate utility such as maintaining an account at a financial institution and sweeping funds represented by a direct deposit, and an account sweep control module. Group II has separate utility such as conducting financial transactions with a cash card.

Inventions Groups II and Group III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention Group II has separate utility such as Group II has separate utility such as conducting financial transactions with a cash card and Group III has separate utility such as providing an anonymous transaction. See MPEP § 806.05(d).

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination as indicated is proper.

6. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II and Group III, the search for

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Group II is not required for Group I and Group III, and the search for Group III is not required for Group I and Group II, restriction for examination purposes as indicated is proper.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

8. Applicants' are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

9. Applicant is advised that the reply to this requirement to be completed must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

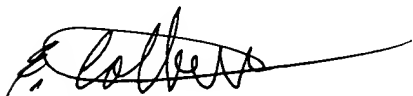
Inquiries

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 703-308-7064. The examiner can normally be reached on Monday-Thursday from 6:30 am -5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1038. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "E. Colbert", with a long horizontal flourish extending to the right.

E. Colbert
November 1, 2004